

**REMARKS/ARGUMENTS**

In response to the Office Action mailed October 31, 2005, reconsideration of this patent application, as presently amended and in light of the following discussion, is respectfully requested. Claims 1-43 and 80-89 are under consideration. Claims 34, 39 and 83 have been amended to correct informalities. No new matter has been added to the claims. Applicants are preparing both replacement Figs 1, 3, 4A and 5A and an Information Disclosure Statement for filing with the U.S.P.T.O. Applicants respond in kind to each portion of the Office Action as follows:

1. The Examiner has stated that the present Action "is responsive to Applicant's restriction election filed August 8, 2005 and amendment filed July 20, 2005." Applicants respectfully note, however, that although a preliminary amendment was filed on November 3, 2004 and a response to a first office action was filed on May 16, 2005, with the subsequent election filed on August 5, 2005, no amendments were filed on July 20, 2005. Instead, a restriction requirement was issued on this date (July 20, 2005) that was responded to by the Applicants, as noted by the Examiner.

2. Applicants note with appreciation the Examiner's withdrawal of his rejection of claims 1-43 and 80-89 in view of Applicants' arguments filed on May 16, 2005. However, with regard to the Examiner's new grounds for rejection, those rejections are traversed as set forth herein.

3. Applicants appreciate the Examiner's acknowledgement of the Applicants' election of claims 1-43 and 80-89, filed on August 5, 2005. Applicants are currently verifying

inventorship in relation to the claim election and will amend the inventorship in accordance with 37 CFR 1.48(b), if necessary.

4. The Examiner has suggested that the invention title be amended to read as follows: "Method and System from [sic] Selecting Building Materials that Meet Project Criteria." Applicants note a possible typographical error in the Examiner's suggested title, whereas the word "from" is used in place of the word "for." In accordance with the Examiner's suggestion, Applicants have amended the title of the application, but substituting the word "for" in place of "from."

5. Claim 89 has been amended to correct an informality. No new matter has been added to the claim. A withdrawal of the objection to this claim is respectfully requested in view of the Applicants' amendment made herein.

6-7. Claim 87 is amended to further define the present invention. Full support for the amendment is found in the specification, inter alia, at pp. 19-20, para. 0037; and p. 37, para. 0078. No new matter has been added to the claim. Applicants respectfully submit that the present amendment to claim 87 is deemed to obviate the rejection of the claim under 35 U.S.C. §112. A withdrawal of the rejection is thus respectfully requested.

8. Claim 16 is amended to further define the present invention. Full support for the amendment is found in the specification, inter alia, at pp. 6-7, paras. 0011-0012. No new matter has been added to the claim. Applicants respectfully submit that the present amendment to claim 16 is deemed to obviate the rejection of the claim under 35 U.S.C. §112. A withdrawal of the rejection is thus respectfully requested.

9-10. 35 U.S.C. § 102(b) anticipation rejections (1-2, 7, 13-14, 17-20, 25, 30-31, 33, 42-43, 82, 84-85 and 89):

Claims 1-2, 7, 13-14, 17-20, 25, 30-31, 33, 42-43, 82, 84-85 and 89 stand rejected under 35 U.S.C. 35 U.S.C. § 102(b) in view of three published articles, namely, Papamichael et al., Building Design Advisor: Automated Integration of Multiple Simulation Tools (1997) (reference A); Papamichael et al., Product Modeling for Computer-aided Decision Making (1999) (reference B); and Papamichael et al., Application of Information Technologies in Building Design Decisions (1999) (reference C). (*Office Action*, Section 10)(emphasis added). The rejection of the foregoing claims is unwarranted and thus traversed where the Examiner has set forth three separate references in combination as anticipating the claims.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference.” M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987))(emphasis added). “When more than one reference is required to establish unpatentability of the claimed invention, anticipation under §102 cannot be found, and validity is determined in terms of §103. *E.g., Continental Can Co., U.S.A. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1748 (Fed. Cir. 1991).

Although M.P.E.P. §2131.01 permits the use of multiple references in support of anticipation rejections, the Office Action does not indicate that the references are cited in accordance with the M.P.E.P. for this purpose. For example, nowhere does the Office Action indicate that one of the references A, B or C is to be considered a primary reference, with the

remaining references cited to explain the meaning of a term of the primary reference or that a characteristic in the primary reference is inherent. If the references A, B and C are indeed cited in combination, such a combined citation is not proper where it appears from the Office Action that a given reference of the three is cited as disclosing of one or more claim limitations not present in one or more of the remaining references, thus combining the teachings of the references to build an anticipation. *See Teleflex, Inc. v. Ficosa North American Corp.*, 63 U.S.P.Q.2d 1374, 1388 (Fed. Cir. 2002)(“Although we have permitted the use of additional references to confirm the contents of the allegedly anticipating reference, . . . we have made clear that anticipation does not permit an additional reference to supply a missing claim limitation.”). A withdrawal of the rejections is thus respectfully requested.

Assuming, arguendo, that the Examiner does not cite the references in combination but instead cites each separate reference in support of the rejection of each claim as listed below, those rejections are nonetheless traversed.

Claims 1, 2, 14, 17, 18, 25, 30, 31, 33, 42, 43, 84, 85 and 89 rejected as anticipated by reference A;

Claims 1, 2, 7, 14, 19, 20, 25, 30, 31, 33, 43, 82, 84, 85 and 89 rejected as anticipated by reference B; and

Claims 1, 2, 7, 13, 14, 17, 18, 19, 20, 33, 43 and 82 rejected as anticipated by reference C.

Anticipation in view of reference A

Claims 1, 2, 14, 17, 18, 25, 30, 31, 33, 42, 43, 84, 85 and 89 stand rejected as anticipated by reference A. The rejection of claim 1 as anticipated by reference A is unwarranted and is hereby traversed. “A claim is anticipated only if *each and every element* as set forth in the claim

is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987))(emphasis added). “The identical invention must be shown in as complete detail as is contained . . . in the claim.” M.P.E.P. § 2131 (*citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)). Exemplary embodiments of the Applicants’ method of selecting items for a project within a criteria include the steps of:

- inputting project information, including project criteria;
- determining, with a computer, sets of items based on the project information that meet the criteria;
- calculating for each set of items a set value;
- selecting a set of items based on the calculated set values; and
- displaying to a user the selected set of items that meet the project criteria.

With regard to claim 1, both the cited portions and the non-cited portions of reference A fail to teach or suggest each of the enumerated steps of the claimed method. For example, nowhere do the cited or non-cited portions of reference A teach or suggest the claim limitations of “determining . . . sets of items based on project information that meet the criteria” or “calculating for each set of items a set value.” Nor do these portions of the reference teach or suggest “selecting a set of items based on the calculated set values.” In contradistinction, reference A teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices, which is evidenced as follows:

"The Desktop allows *building designers* to compare multiple design alternatives with respect to multiple descriptive and performance parameters . . ."

(Reference A, p. 1, para. 2)(emphasis added).

"Through its graphical user-interface, the core program allows *users* to . . . review results from computations and data queries in a variety of graphical displays."

(Id. at p. 3, para. 3)(emphasis added).

"The main objectives of the GUI design were to allow *building designers* to . . . compare many alternative building designs with respect to many descriptive and performance parameters."

(Id. at p. 6, para. 4)(emphasis added).

"The Decision Desktop allows *the user to compare multiple alternative designs* with respect to any number of input and output parameters addressed by the simulation tools linked to the BDA."

(Id. at p. 7, caption to fig. 3)(emphasis added).

In view of the foregoing, it thus follows that the BDA displays "alternative designs" for comparison by the user, not the "selected set of items that meet the project criteria" called out by claim 1. (See Reference A, p. 7, fig. 3 and caption).

Applicants note that if the Examiner is indeed citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P, then such a citation further supports Applicants' position that the BDA does not teach or suggest the "selecting" and "displaying" limitations of claim 1, as evidenced by the following excerpt from reference C:

The need to also address performance aspects such as comfort, cost, aesthetics, etc., *require a multi-criterion judgment, which cannot be specified and delegated to others, let alone machines. Decision-making is the main non-delegable design task and can only be addressed by the designers themselves.* Moreover, it can only be addressed *through direct, side-by-side comparison of multiple design alternatives.* With the exception of this type of multi-criterion optimization, the rest of the design tasks can be specified and delegated to others, especially computers. . . . This recognition has been the basis for the development of the BDA software, in an attempt to . . . assist decision-makers with the parts of the design process that requires human judgment.

(Reference C, p. 5, col. 1, paras. 1-2)(emphasis added).

Thus, because claim 1 is patentably distinguishable from the prior art, the rejection of claim 1 is unwarranted and a withdrawal of the rejection of the claim is respectfully requested.

Claims 2, 14, 17, 18, 25, 30, 31, 84 and 85 directly or indirectly depend from claim 1 and include all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 1, a withdrawal of the rejection of these claims is respectfully requested.

With further regard to claim 2, the Office Action cites to references B and C, but not reference A, as “storing the calculated value(s) in a database.” (*Office Action*, p. 7). However, claim 2 recites that “the items are stored in at least one database and each item has an associated first item value and second item value.” Thus, where the Office Action fails to address each limitation of claim 2 and also fails to recite that each limitation is taught by reference A, a withdrawal of the rejection of claim 2, as well as those claims depending therefrom, is requested for these reasons as well.

The rejection of claim 33 as anticipated by reference A is unwarranted and is hereby traversed. Exemplary embodiments of the Applicants’ system for selecting a set of items that meet a given criteria include the components of:

- a central computer having a processor and an input device for receiving information on a project;

- at least one database having a list of items that may be used in constructing the project and a first value for each of the items;

- code for determining sets of items that may be used in constructing the project;

- code for calculating a total first values for each set of items;

- code for selecting a set of items based on the calculated total first values; and

code for displaying to a user the selected set of items.

Applicants respectfully submit that no support is provided in the Office Action that each element of claim 33 is disclosed in reference A. Instead, the Office Action merely states that claim 33 is taught by the BDA while broadly citing to various portions of each reference. (*Office Action*, p.5, bottom paragraph to p. 6, top paragraph). However, nowhere does the Office Action address where each recited limitation of claim 33 is disclosed in the references. Applicants respectfully submit that the rejection of claim 33 appears to be in non-compliance with section 707.07(d) of the M.P.E.P. The withdrawal of the rejection of claim 33, and of the claims depending therefrom, is thus respectfully requested.

If the Examiner relies on inherency in rejecting any of the above claims, the Examiner is respectfully invited to present extrinsic evidence to support his assertions that the claimed steps or elements are present in the cited references. *See Continental Can Co., U.S.A. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749-50 (Fed. Cir. 1991). In presenting any assertion of inherency, the Examiner is also respectfully invited to point to the *page and line no.* of the prior art that justifies the rejection. *See Ex parte Schricker*, 56 U.S.P.Q.2d 1723, 1725 (B.P.A.I. 2000) (“The examiner has left the applicant and the board to guess at the basis of the rejection . . . and what part of which document supports the rejection. . . [w]e decline to guess”)(unpublished).

Assuming, arguendo, that the rejection of claim 33 is adequately set forth within the Office Action, the rejection is nonetheless traversed where the prior art does not disclose or suggest each limitation of the claim. For example, nowhere does reference A disclose or suggest “code for selecting a set of items based on the calculated total first values.” In contradistinction,



reference A teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices. (*See Response*, pp. 28-29, *supra*).

Again, if the Examiner is citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P, then such a citation further supports Applicants' position that the BDA does not teach or suggest the foregoing limitation of claim 33. (*See Response*, p. 29, *supra*). Thus, because claim 33 is patentably distinguishable from the prior art, the rejection of claim 33 is unwarranted and a withdrawal of the rejection of the claim is respectfully requested.

Claims 42, 43 and 89 directly or indirectly depend from claim 33 and include all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 33, the withdrawal of the rejection of these claims is respectfully requested.

Applicants note that the Examiner has rejected claim 43 as anticipated by the references as depending from claim 33. However, claim 43 depends from claim 33 via claims 34 and 36. Nowhere does section 10 of the Office Action address where each limitation of claims 34 or 36 is met by the anticipation references, nor are claims 34 and 36 recited in the section as anticipated thereby. (*Office Action*, p. 5). To the contrary, pp. 47 and 30 of the Office Action, in support of the respective obviousness rejections of the claims, respectively recite that the BDA does not expressly teach the limitations of claims 34 and 36. The withdrawal of the rejection of claim 43 is thus requested for these reasons as well. Clarification of the anticipation status of

claims 34 and 36 is also requested.

For the foregoing reasons, because a prima facie case of anticipation has not been established for claims 1, 2, 14, 17, 18, 25, 30, 31, 33, 42, 43, 84, 85 and 89, Applicants respectfully request that the rejection of the claims be withdrawn.

With further regard to claim 43 and the Examiner's comments relating to amending the claim to reflect a method that receives and stores information, Applicants note that claim 43 is a system claim that further comprises an administrative server computer adapted to receive updated material cost information and to update the at least one database of the system with the updated material cost information. Applicants have thus respectfully not amended the claim in accordance with the Examiner's comments.

Anticipation in view of reference B

Claims 1, 2, 7, 14, 19, 20, 25, 30, 31, 33, 43, 82, 84, 85 and 89 stand rejected as anticipated by reference B. As a preliminary matter, Applicants note that on p. 6 of the Office Action, the Examiner has cited the following paragraph as located on p. 3, col. 2, para. 1 of reference C:

"The main objective of the Building Design Advisor (BDA) project is to develop a computer-based tool that allows building decision-makers to quickly and easily integrate energy considerations into decision-making, throughout the early phases of building design."

However, because this paragraph is located on p. 3, col. 2, para. 1 of reference B, Applicants will address the rejections associated with reference B to include citations to this paragraph accordingly. Furthermore, the Applicants note inconsistencies in the page numbers of reference B. Because the writings and figures of reference B appear to be consistent, despite the

inconsistent page numbers, Applicants will respond to the rejections in view of this reference and in accordance with the Examiner's citations. Applicants nonetheless request that the Examiner confirm the pagination of the reference and provide clarification.

The rejection of claim 1 as anticipated by reference B is unwarranted and is hereby traversed. "A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987))(emphasis added). "The identical invention must be shown in as complete detail as is contained . . . in the claim." M.P.E.P. §2131 (*citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)).

Applicants respectfully submit that no support is provided in the Office Action that each element of claim 1 is disclosed in reference B. Nowhere does the Office Action address where the "inputting," "selecting" or "displaying" limitations of the claim are disclosed in reference B. Thus, where the Office Action fails to address where each limitation of claim 1 is taught by reference B, a withdrawal of the rejection of claim 1, as well as those claims depending therefrom, is respectfully requested.

Furthermore, the cited portions and non-cited portions of reference B fail to teach or suggest each of the enumerated steps of the claimed method. For example, nowhere do the cited or non-cited portions of reference B teach or suggest the claim limitations of "determining . . . sets of items based on project information that meet the criteria" or "calculating for each set of items a set value." Nor do these portions of the reference teach or suggest "selecting a set of

items based on the calculated set values.” In contradistinction, reference B teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices, which is evidenced as follows:

“Since performance evaluation requires comparison among alternatives [by building designers], we support the evaluation of concurrent design solutions. . . . The Decision Desktop allows multi-criterion decision-making [by building designers], through comparison of multiple alternative design solutions with respect to multiple performance parameters.”

(*Reference B*, p. 4, col. 1, paras. 1-2).

“To satisfy the need for performance evaluation, the BDA supports multiple design alternatives within a project database. . . . The BDA user interface supports the concurrent review and manipulation of any number of alternative design solutions. . . . Moreover, it supports their side-by-side comparison [by users] with respect to multiple performance considerations.”

(*Id.* at p. 5, col. 1, para. 1).

In view of the foregoing, it thus follows that the Decision Desktop of the graphical user interface of the BDA displays “multiple alternative design solutions” for comparison by the user, not the “selected set of items that meet the project criteria” called out by claim 1. (*See Reference B*, p. 4, col. 1, paras. 1-2).

Again, if the Examiner is citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P, then such a citation further supports Applicants’ position that the BDA does not teach or suggest the “selecting” or “displaying” limitations of claim 1, as evidenced by the following excerpt from reference C:

The need to also address performance aspects such as comfort, cost, aesthetics, etc., *require a multi-criterion judgment, which cannot be specified and delegated to others, let alone machines. Decision-making is the main non-delegable design task and can only be addressed by the designers themselves.* Moreover, it can only be addressed *through direct, side-by-side comparison of multiple design alternatives.* With the exception of this type of multi-criterion optimization, the rest of the design tasks can be specified and delegated to others, especially computers. . . . This recognition has been the

basis for the development of the BDA software, in an attempt to ... assist decision-makers with the parts of the design process that requires human judgment.  
(*Reference C*, p. 5, col. 1, paras. 1-2)(emphasis added).

Thus, because claim 1 is patentably distinguishable from the prior art, the rejection of claim 1 is unwarranted and a withdrawal of the rejection the claim is respectfully requested.

Claims 2, 7, 14, 19, 20, 25, 30, 31, 82, 84 and 85 directly or indirectly depend from claim 1 and include all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 1, withdrawal of the rejection of these claims is respectfully requested.

Again, with further regard to claim 2, the Office Action cites to references B and C as “storing the calculated value(s) in a database.” (*Office Action*, p. 7). However, claim 2 recites that “the items are stored in at least one database and each item has an associated first item value and second item value.” Thus, where the Office Action fails to address each limitation of claim 2, a withdrawal of the rejection of claim 2, as well as those claims depending therefrom, is requested for this reason as well.

The rejection of claim 33 as anticipated by reference B is unwarranted and is hereby traversed. Applicants respectfully submit that no support is provided in the Office Action that each element of claim 33 is disclosed in reference B. Instead, the Office Action merely states that claim 33 is taught by the BDA while broadly citing to various portions of each reference. (*Office Action*, p.5, bottom paragraph to p. 6, top paragraph). However, nowhere does the Office Action address where each recited limitation of claim 33 is disclosed in the references. Applicants respectfully submit that the rejection of claim 33 appears to be in non-compliance

with section 707.07(d) of the M.P.E.P. The withdrawal of the rejection of claim 33, and of the claims depending therefrom, is thus respectfully requested.

If the Examiner relies on inherency in rejecting any of the above claims, the Examiner is respectfully invited to present extrinsic evidence to support his assertions that the claimed steps or elements are present in the cited references. *See Continental Can Co., U.S.A. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749-50 (Fed. Cir. 1991). In presenting any assertion of inherency, the Examiner is also respectfully invited to point to the *page and line no.* of the prior art that justifies the rejection. *See Ex parte Schricker*, 56 U.S.P.Q.2d 1723, 1725 (B.P.A.I. 2000) (“The examiner has left the applicant and the board to guess at the basis of the rejection . . . and what part of which document supports the rejection. . . [w]e decline to guess”)(unpublished).

Assuming, *arguendo*, that the rejection of claim 33 is adequately set forth within the Office Action, the rejection is nonetheless traversed where the prior art does not disclose or suggest each limitation of the claim. For example, nowhere does reference B disclose or suggest “code for selecting a set of items based on the calculated total first values.” In contradistinction, reference B teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices. (*See Response*, p. 35, *supra*).

Again, if the Examiner is citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P., then such a citation further supports Applicants’ position that the BDA does not teach or suggest the foregoing limitation of claim 33. (*See Response*, pp. 35-36, *supra*). Thus, because claim 33 is

patentably distinguishable from the prior art, the rejection of claim 33 is unwarranted and a withdrawal of the rejection of the claim is respectfully requested.

Claims 43 and 89 directly or indirectly depend from claim 33 and include all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 33, the withdrawal of the rejection of these claims is respectfully requested.

Applicants note that the Examiner has rejected claim 43 as anticipated by the references as depending from claim 33. However, claim 43 depends from claim 33 via claims 34 and 36. Nowhere does section 10 of the Office Action address where the limitations of claims 34 and 36 are met by the anticipation references, nor are claims 34 and 36 recited in the section as anticipated thereby. (*See Office Action*, p. 5). To the contrary, pp. 47 and 30 of the Office Action, in support of the respective anticipation rejections of the claims, respectively recite that the BDA does not expressly teach the limitations of claims 34 and 36. The withdrawal of the rejection of claim 43 is thus requested for these reasons as well. Clarification of the anticipation status of claims 34 and 36 is also requested.

For the foregoing reasons, because a prima facie case of anticipation has not been established for claims 1, 2, 7, 14, 19, 20, 25, 30, 31, 33, 43, 82, 84, 85 and 89, Applicants respectfully request that the rejection of the claims be withdrawn.

Anticipation in view of reference C

Claims 1, 2, 7, 13, 14, 17, 18, 19, 20, 33, 43 and 82 stand rejected as anticipated by reference C. As noted above in Applicants' analysis of the anticipation rejections of reference B,

the “main objective” of the BDA cited on p. 6 of the Office Action is located in reference B (p. 3, col. 2, para 1) and not reference C. Thus, Applicants will not address the rejections associated with reference C to include this paragraph. Instead, Applicants will address the rejections associated with reference C as including p. 14 and figures 1 & 2 of that reference, as cited on p. 6 of the Office Action.

The rejection of claim 1 as anticipated by reference C is unwarranted and is hereby traversed. “A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987))(emphasis added). “The identical invention must be shown in as complete detail as is contained . . . in the claim.” M.P.E.P. § 2131 (*citing Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)).

Applicants respectfully submit that the Examiner has not provided any support that each element of claim 1 is disclosed in reference C. Nowhere does the Office Action address where the “inputting” limitations of the claim are disclosed in reference C. Thus, where the Office Action fails to address where each limitation of claim 1 is taught by reference C, a withdrawal of the rejection of claim 1, as well as those claims depending therefrom, is respectfully requested.

Furthermore, with regard to claim 1, both the cited portions and the non-cited portions of reference C fail to teach or suggest each of the enumerated steps of the claimed method. For example, nowhere do the cited or non-cited portions of reference C teach or suggest the claim limitations of “determining . . . sets of items based on project information that meet the criteria.”



With regard to the “calculating” limitation of the claim, Applicants note that the Examiner has cited to page 14 of reference C as teaching this feature. In addition to not teaching or suggesting this limitation of the claim, the cited portion discusses “future directions” of the BDA and “ways in which the BDA environment can be expanded and enhanced.” (*Reference C*, p. 13, col. 2, para. 3; p. 14, paras. 1-2). However, the fact that a prior art reference is capable of being modified and the modification would anticipate the invention is not sufficient to support anticipation. *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1951 (Fed. Cir. 1999)(“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”(citations omitted).

Nor do the cited or non-cited portions of the reference teach or suggest “selecting a set of items based on the calculated set values.” In contradistinction, reference C teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices, which is evidenced as follows:

Performance prediction is mandatory, but not adequate for decision-making. Once performance has been predicted, it has to be evaluated with respect to its goodness or appropriateness. Since ‘good’ or ‘bad’ makes sense only when there are at least two of a kind, *evaluation requires comparison of multiple alternative design schemes .... While performance prediction can be highly automated through the use of computers, performance evaluation cannot, unless it is with respect to a single criterion. The multi-criterion nature of most design decisions requires the direct involvement of humans.* (*Reference C*, p. 3, col. 1, paras 2-3)(emphasis added).

The need to also address performance aspects such as comfort, cost, aesthetics, etc., *require a multi-criterion judgment, which cannot be specified and delegated to others, let alone machines. Decision-making is the main non-delegable design task and can only be addressed by the designers themselves.* Moreover, it can only be addressed *through direct, side-by-side comparison of multiple design alternatives.* With the exception of this type of multi-criterion optimization, the rest of the design tasks can be specified and delegated to others, especially computers..... This recognition has been the basis for the development of the BDA software, in an attempt to ... assist decision-makers with the parts of the design process that requires human judgment.

(*Id.* at p. 5, col. 1, paras. 1-2)(emphasis added).

“The Decision Desktop is a matrix that facilitates the comparison [by designers] of multiple design solutions with respect to multiple parameters.”

(*Id.* at p. 9, col. 2, para. 2).

“The Decision Desktop allows *designers to compare* multiple design solutions with respect to multiple descriptive and performance characteristics.”

(*Id.* at p. 11, fig. 10, caption)(emphasis added).

In view of the foregoing, it thus follows that the Decision Desktop of the graphical user interface of the BDA displays “multiple design solutions” for comparison by the user, not the “selected set of items that meet the project criteria” called out by claim 1. (*See Reference C*, p. 9, col. 2, para. 2; p. 11, fig. 10, caption).

Again, if the Examiner is citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P, then such a citation further supports Applicants’ position that the BDA does not teach or suggest the “selecting” or “displaying” limitations of claim 1. (*See Response*, pp. 28-29 and 35, *supra*). Thus, because claim 1 is patentably distinguishable from the prior art, the rejection of claim 1 is unwarranted and a withdrawal of the rejection of the claim is respectfully requested.

Claims 2, 7, 13, 14, 17, 18, 19, 20 and 82 directly or indirectly depend from claim 1 and include all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 1, withdrawal of the rejection of these claims is respectfully requested.

Again, with further regard to claim 2, the Office Action cites to references B and C as “storing the calculated value(s) in a database.” (*Office Action*, p. 7). However, claim 2 recites that “the items are stored in at least one database and each item has an associated first item value

and second item value.” Thus, where the Office Action fails to address each limitation of claim 2, a withdrawal of the rejection of claim 2, as well as those claims depending therefrom, is requested for this reason as well.

The rejection of claim 33 as anticipated by reference C is unwarranted and is hereby traversed. Applicants respectfully submit that no support is provided in the Office Action that each element of claim 33 is disclosed in reference C. Instead, the Office Action merely states that claim 33 is taught by the BDA while broadly citing to various portions of each reference. (*Office Action*, p.5, bottom paragraph to p. 6, top paragraph). However, nowhere does the Office Action address where each recited limitation of claim 33 is disclosed in the references. Applicants respectfully submit that the rejection of claim 33 appears to be in non-compliance with section 707.07(d) of the M.P.E.P. The withdrawal of the rejection of claim 33, and of the claims depending therefrom, is thus respectfully requested.

If the Examiner relies on inherency in rejecting any of the above claims, the Examiner is respectfully invited to present extrinsic evidence to support his assertions that the claimed steps or elements are present in the cited references. *See Continental Can Co., U.S.A. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749-50 (Fed. Cir. 1991). In presenting any assertion of inherency, the Examiner is also respectfully invited to point to the *page and line no.* of the prior art that justifies the rejection. *See Ex parte Schricker*, 56 U.S.P.Q.2d 1723, 1725 (B.P.A.I. 2000)(“The examiner has left the applicant and the board to guess at the basis of the rejection . . . and what part of which document supports the rejection. . . [w]e decline to guess”)(unpublished).

Assuming, arguendo, that the rejection of claim 33 is adequately set forth within the

Office Action, the rejection is nonetheless traversed where the prior art does not disclose or suggest each limitation of the claim. For example, nowhere does reference C disclose or suggest “code for selecting a set of items based on the calculated total first values.” In contradistinction, reference C teaches that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices. (*See Response*, pp. 40-41, *supra*).

Again, if the Examiner is citing multiple references A, B and C in support of his anticipation rejection of the claims in accordance with section 2131.01 of the M.P.E.P., then such a citation further supports Applicants’ position that the BDA does not teach or suggest the foregoing limitation of claim 33. (*See Response*, p. 41, *supra*). Thus, because claim 33 is patentably distinguishable from the prior art, the rejection of claim 33 is unwarranted and a withdrawal of the rejection of the claim is respectfully requested.

Claim 43 indirectly depends from claim 33 and includes all of the features of that claim plus additional features. Therefore, for the at least the reasons set forth above with respect to claim 33, the withdrawal of the rejection of this claim is respectfully requested.

Applicants note that the Examiner has rejected claim 43 as anticipated by the references as depending from claim 33. However, claim 43 depends from claim 33 via claims 34 and 36. Nowhere does section 10 of the Office Action address where the limitations of claims 34 and 36 are met by the anticipation references, nor are claims 34 and 36 recited in the section as anticipated thereby. (*See Office Action*, p. 5). To the contrary, pp. 47 and 30 of the Office Action, in support of the obviousness respective rejections of the claims, respectively recite that

that the BDA does not expressly teach the limitations of claim 34 and 36. The withdrawal of the rejection of claim 43 is thus requested for these reasons as well. Clarification of the anticipation status of claims 34 and 36 is also requested.

For the foregoing reasons, because a *prima facie* case of anticipation has not been established for claims 1, 2, 7, 13, 14, 17, 18, 19, 20, 33, 43 and 82, Applicants respectfully request that the rejection of the claims be withdrawn.

11-12. 35 U.S.C. §103(a) obviousness rejections (claims 3-6, 10-12, 15-16, 21-24, 26, 35-38, 40 and 80-81)

Claims 3-6, 10-12, 15-16, 21-24, 26, 35-38, 40 and 80-81 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C as applied to claims 1-2, 7, 13-14, 17-20, 25, 30-31, 33, 42-43, 82, 84-85 and 89 and further in view of MECcheck Software User's Guide Version 3.0.

Claims 3, 12, 15 and 80:

Claims 3, 12, 15 and 80 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C as applied to claims 1 and 2 and further in view of MECcheck software User's Guide Version 3.0.

The rejection of claims 3, 12, 15 and 80 under §103(a) as unpatentable over references A, B, and C in view of MECheck is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). "All words in a claim must be considered in judging the patentability of that claim

against the prior art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 3 (pp. 16-18), 12 (pp. 22-24), 15 (pp. 24-25) and 80 (pp. 37-38) fail to address each element of claim 1, from which claim 15 depends, or of claims 1 and 2, from which claims 3, 12 and 80 depend, as called for by M.P.E.P. §706.02(j) in support of the rejection of these claims.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the limitations of claim 2 are nonetheless inadequately supported therein (*see Response*, pp. 30, 36 and 41-42, *supra*) while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. In contradistinction, with regard to the “selecting” limitation of claim 1, the references teach that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices, which is evidenced as follows:

“The Desktop allows *building designers* to compare multiple design alternatives with respect to multiple descriptive and performance parameters . . .”  
(*Reference A*, p. 1, para. 2)(emphasis added).

“Through its graphical user-interface, the core program allows *users* to . . . review results from computations and data queries in a variety of graphical displays.”  
(*Id.* at p. 3, para. 3)(emphasis added).

“The main objectives of the GUI design were to allow *building designers* to . . . compare many alternative building designs with respect to many descriptive and performance parameters.”  
(*Id.* at p. 6, para. 4)(emphasis added).

“The Decision Desktop allows *the user* to compare multiple alternative designs with respect to any number of input and output parameters addressed by the simulation tools linked to the BDA.”  
(*Id.* at p. 7, caption to fig. 3)(emphasis added).

"Since performance evaluation requires comparison among alternatives [by building designers], we support the evaluation of concurrent design solutions. . . . The Decision Desktop allows multi-criterion decision-making [by building designers], through comparison of multiple alternative design solutions with respect to multiple performance parameters."

(Reference B, p. 4, col. 1, paras. 1-2).

"To satisfy the need for performance evaluation, the BDA supports multiple design alternatives within a project database. . . . The BDA user interface supports the concurrent review and manipulation of any number of alternative design solutions. . . . Moreover, it supports their side-by-side comparison [by users] with respect to multiple performance considerations.."

(Id. at p. 5, col. 1, para. 1).

Performance prediction is mandatory, but not adequate for decision-making. Once performance has been predicted, it has to be evaluated with respect to its goodness or appropriateness. Since 'good' or 'bad' makes sense only when there are at least two of a kind, *evaluation requires comparison of multiple alternative design schemes .... While performance prediction can be highly automated through the use of computers, performance evaluation cannot, unless it is with respect to a single criterion. The multi-criterion nature of most design decisions requires the direct involvement of humans.*

(Reference C, p. 3, col. 1, paras 2-3)(emphasis added).

The need to also address performance aspects such as comfort, cost, aesthetics, etc., *require a multi-criterion judgment, which cannot be specified and delegated to others, let alone machines. Decision-making is the main non-delegable design task and can only be addressed by the designers themselves.* Moreover, it can only be addressed *through direct, side-by-side comparison of multiple design alternatives.* With the exception of this type of multi-criterion optimization, the rest of the design tasks can be specified and delegated to others, especially computers. .... This recognition has been the basis for the development of the BDA software, in an attempt to ... assist decision-makers with the parts of the design process that requires human judgment.

(Id. at p. 5, col. 1, paras. 1-2)(emphasis added).

"The Decision Desktop is a matrix that facilitates the comparison [by designers] of multiple design solutions with respect to multiple parameters."

(Id. at p. 9, col. 2, para. 2).

"The Decision Desktop allows *designers to compare* multiple design solutions with respect to multiple descriptive and performance characteristics."

(Id. at p. 11, fig. 10, caption)(emphasis added).

Nor does MECcheck teach or suggest this limitation. In contradistinction, the MECcheck Software User's Guide teaches that "[t]he software enables *you* [i.e. the designer] to quickly compare different insulation levels in different parts of your building to arrive at a package that works best for you." (MECcheck, Software User's Guide, p.1, para. 3)(emphasis added).

Applicants thus respectfully submit that these references teach away from the claimed invention. *See In re Gurley*, 31 U.S.P.Q.2d 1130, 1131 (Fed. Cir. 1994)(a reference teaches away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant); *see also In re Caldwell*, 138 U.S.P.Q. 243, 246 (C.C.P.A. 1963)(reference teaches away if it leaves the impression that that the product would not have the property sought by applicant). The fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI); *see also W. L. Gore & Assocs. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)(the totality of the reference's teachings must be considered).

With further regard to claim 80, Applicants note that the Examiner has asserted that providing energy budgets for projects as a mechanism for defining design constraints for a project is "old and well known," using this assertion as the *principal evidence* upon which the rejection is based. Applicants respectfully submit that "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based." M.P.E.P. §2144.03(A)(para. 3) and (E)(*citing In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001)).

Applicants also respectfully submit that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. M.P.E.P. §2144.03(A)(para. 2); *see In re Ahlert*, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970).



Applicants respectfully submit that the use of energy budgets in relation to selecting project items requires knowledge peculiar to a particular art, and is not capable of such instant and unquestionable demonstration as to defy dispute. *See In re Ahlert*, 165 U.S.P.Q. at 420-21. The Examiner is thus respectfully invited to provide documentary evidence in support of his finding that the fact is well known in the art. M.P.E.P. §2144.04(C). If the Examiner is relying on his personal knowledge of this fact, he is respectfully invited to provide an affidavit or declaration setting forth specific factual statements and explanations in support of the finding. *Id.*; *see* 37 C.F.R. § 1.104(d)(2).

Thus, where the cited references, alone or in combination, fail to teach or suggest the aforementioned limitation, claims 3, 12, 15 and 80, read respectively with all of the limitations of claim 1 or claims 1 and 2, do not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). Because claims 3, 12, 15 and 80 are patentably distinguishable from the prior art, the withdrawal of the rejection of these claims is respectfully requested. Furthermore, because claims 3, 12 and 80 directly depend from improperly-rejected claim 2 (*see Response*, pp. 30, 36 and 41-42, *supra*) the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

Claims 4, 5, 6, 10, 11, 16, 21, 22, 23, 24, 26 and 81 directly or indirectly depend from claim 3 and include all of the limitations of that claim plus additional limitations. Therefore, for at least the reasons set forth above in support of the non-obviousness of claim 3, Applicants respectfully submit that these claims are patentably distinguishable over the cited references as

well. If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. M.P.E.P. §2143.03(*citing In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)). The withdrawal of the rejection of these claims is thus respectfully requested.

With further regard to claim 11, Applicants note that the Examiner has asserted that representing project values as a glazing percentage is “old and very well known.” Applicants respectfully submit that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. M.P.E.P. §2144.03(A)(para. 2); *see In re Ahlert*, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970). Applicants respectfully submit that using a glazing area percentage as a second project value in the determining step of the claimed method requires knowledge peculiar to a particular art, and is not capable of such instant and unquestionable demonstration as to defy dispute. *See In re Ahlert*, 165 U.S.P.Q. at 420-21. The Examiner is thus respectfully invited to provide documentary evidence in support of his finding that the fact is well known in the art. M.P.E.P. §2144.04(C). If the Examiner is relying on his personal knowledge of this fact, he is respectfully invited to provide an affidavit or declaration setting forth specific factual statements and explanations in support of the finding. *Id.*; *see* 37 C.F.R. § 1.104(d)(2).

Claims 35-38, 40

Claims 35-38 and 40 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C as applied to claim 33 and further in view of MECcheck Software User’s Guide Version 3.0.

The rejection of claim 35 over references A, B, and C in view of MECcheck is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (*citing In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Again, Applicants respectfully submit that the Examiner has not established *prima facie obviousness*. The portions of the Office Action in support of the rejection of claim 35 (pp. 29-30) fail to address each element of claim 33, from which claim 35 depends. Again, for example, nowhere does the Office Action, as called for by M.P.E.P. 706.02(j) in support of the rejections of these claims, address where “code for selecting a set of items based on the calculated total first values” is taught or suggested by the BDA as evidenced by references A, B and C, alone or in combination. In contradistinction, the references teach away from this limitation. (*See Response*, pp. 45-46, *supra*). Nor does the MECcheck reference, alone or in combination, teach or suggest at least this limitation, with the reference instead again teaching away from the claimed invention. (*See Id.* pp. 46-47, *supra*). Again, the fact that the references teach away from the claimed invention is a factor to be considered against a finding to combine or modify them. *See* M.P.E.P. §2141.02(VI); *see also W. L. Gore & Assocs. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)(the totality of the reference’s teachings must be considered).

Thus, where the cited references, alone or in combination fail to teach or suggest this

limitation, claim 35, read respectively with all of the limitations of claim 33, does not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claim 35 is patentably distinguishable from the prior art, the withdrawal of the rejection of the claim is respectfully requested.

Applicants note that claims 36-38 and 40 have been rejected over references A, B and C in view of MECcheck. However claims 36-38 directly or indirectly depend from claim 34, while claim 40 directly depends from claim 39, with Section 12 of the Office Action failing to recite these claims or discuss their features in view of these cited references, as called for by M.P.E.P. 706.02(j). Although claims 34 and 39 are respectively rejected in sections 15 and 16 of the Office Action, these rejections are in view of additional references not discussed in the present section (i.e. not discussed in section 12). Accordingly, Applicants respectfully request the withdrawal of the rejections of claims 36-38 and 40, and for clarification of the status of claims 34 and 39 with regard to section 12 of the Office Action.

With further regard to claims 37 and 38, Applicants note that the Examiner has asserted that representing project values as a glazing percentage is "old and very well known." Applicants respectfully submit that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. M.P.E.P. §2144.03(A)(para. 2); *see In re Ahlert*, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970). Applicants respectfully submit that, with regard to claim no. 37, having code that calculates at least one

glazing area percentage and code that determines sets of items associated with the calculated percentage requires knowledge peculiar to a particular art, and is not capable of such instant and unquestionable demonstration as to defy dispute. *See In re Ahlert*, 165 U.S.P.Q. at 420-21.

Applicants further respectfully submit that, with regard to claim no. 38, using glazing area percentages in a code's evaluation of item combinations also requires knowledge peculiar to a particular art, and is also not capable of such instant and unquestionable demonstration as to defy dispute. *See Id.* The Examiner is thus respectfully invited to provide documentary evidence for each claim in support of his finding that the fact is well known in the art. M.P.E.P. §2144.04(C). If the Examiner is relying on his personal knowledge of this fact, he is respectfully invited to provide an affidavit or declaration setting forth specific factual statements and explanations in support of the finding. *Id.*; *see* 37 C.F.R. § 1.104(d)(2).

In summation, because of the foregoing reasons, a withdrawal of the rejection of claims 3, 4, 5, 6, 10, 11, 12, 15, 16, 21, 22, 23, 24, 26, 35-38, 40 and 80-81 is respectfully requested.

13. 35 U.S.C §103(a) obviousness rejection (claims 8-9)

Claims 8 and 9 stand rejected under 35 U.S.C §103(a) as unpatentable over the BDA as evidenced by references A, B and C as applied to claims 1 and 2 and further in view of Bosch. The rejection of claims 8 and 9 under §103 as unpatentable over references A, B, and C in view of Bosch is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). "All words in a claim must be considered in judging the patentability of that claim against the prior

art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claims 8 and 9 (pp. 39-41) fail to address each element of claims 1 and 2, from which claims 8 and 9 directly or indirectly depend. For example, although the Office Action briefly discusses “selecting items,” nowhere does the Action, as called for by M.P.E.P. §706.02(j) in support of the rejection, address where the remaining limitations of claim 1 or the “associated first item value and second item value” limitation of claim 2 are taught or suggested by the BDA as evidenced by references A, B and C, alone or in combination.

Assuming, arguendo, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the limitations of claim 2 are nonetheless inadequately supported therein (*see Response*, pp 30, 36 and 41-42, *supra*) while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. In contradistinction, with regard to the “selecting” limitation of claim 1, the references teach that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices. (*See Response*, pp. 45-46, *supra*).

Nor does Bosch teach or suggest this limitation. In contradistinction and as acknowledged by the Examiner, Bosch teaches a system “that would help designers select the most appropriate and cost-effective combination of materials for their buildings.” (*Office Action*, p. 40, para. 4)(*citing Bosch*). Applicants thus respectfully submit that the cited references teach

away from the claimed invention, with such teachings to be considered against a finding to combine or modify them. (*See Response*, p. 47, *supra*).

Thus, where the cited references, alone or in combination, fail to teach or suggest the aforementioned limitation, claims 8 and 9, read respectively with all of the limitations of claims 1 and 2, do not define obvious subject matter, regardless of whether or not the added limitations of each dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974). Because claims 8 and 9 are patentably distinguishable from the prior art, the withdrawal of the rejection of these claims is respectfully requested. Furthermore, because claims 8 and 9 directly or indirectly depend from improperly-rejected claim 2 (*see Response*, pp. 30, 36 and 41-42, *supra*), the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

14. 35 U.S.C. §103(a) obviousness rejections (claims 27-28)

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck as applied to claims 1 and 2 and further in view of Jung, U.S. Patent Publication No. 2001/0037190.

The rejection of claim 27 as unpatentable over references A, B, and C in view of MECcheck and in further view of Jung is not warranted and is hereby traversed. Applicants agree with the Examiner that the BDA evidenced in references A, B and C does not teach “generating a bill of materials based on the selected set of items.” Applicants submit that this claimed limitation is not taught by MECcheck as well. The Examiner thus relies on Jung as teaching this limitation.

Under Section 103, prior art references must have an effective date prior to the Applicants' date of invention, i.e., at least February 21, 2001, Applicants' filing date. The Applicants note, however, that Jung does not qualify as prior art because its April 24, 2001 filing date does not pre-date that of the present application. Although Jung claims priority to a number of foreign patents, a U.S. patent application is not effective on the filing date of an earlier-filed foreign patent application under §119. *In re. Hilmer*, 149 U.S.P.Q. 480 (C.C.P.A. 1966). The withdrawal of the rejection of claim 27, and of claim 28 as depending therefrom, is thus respectfully requested. Upon examination of the Jung publication, Applicants note that one or more of the publication's foreign priority documents may have publication dates possibly relevant to the examination of the present application. However, the Examiner has not cited any of these foreign priority documents, nor are Applicants aware of their content.

In addition to the foregoing reasons for the withdrawal of the rejection of claims 27 and 28, because these claims indirectly depend from improperly-rejected claim 2 (*see Response*, pp. 30, 36 and 41-42, *supra*), a withdrawal of the rejection of claims 27 and 28 is respectfully requested for this reason as well.

15. 35 U.S.C. §103(a) obviousness rejection (claims 29, 32, 34, 80, 83, 86-88)

Claims 29, 32, 34, 80, 83 and 86-88 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck and Jung as applied to claims 1-28, 30-31, 33, 35-38, 40, 42-43, 80-82, 84-85 and 89 and further in view of Wares, U.S. Patent Publication No. 2001/0044768.



Claim 29

Claim 29 stands rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck and Jung as applied to claims 1, 2, 3 and 27 and further in view of Wares. The rejection of claim 29 as unpatentable over references A, B, and C in view of MECcheck and Jung and in further view of Wares is not warranted and is hereby traversed. Applicants agree with the Examiner's finding that the BDA does not teach generating a bill of materials. However, claim 29 directly depends from claim 27. As noted in Applicant's arguments for the withdrawal of the rejection of claim 27, Jung does not qualify as prior art because its filing date does not pre-date that of the present application. The withdrawal of the rejection of claim 29 is thus respectfully requested as depending from an improperly rejected claim. Furthermore, because claim 29 indirectly depends from improperly-rejected claim 2 (*see Response*, pp. 30, 36 and 41-42, *supra*), the withdrawal of the rejection of this claim is respectfully requested for this reason as well.

Claims 32 and 80

Claims 32 and 80 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck and Jung as applied to claims 1 and 2 and further in view of Wares. The rejection of claims 32 and 80 under §103 as unpatentable over references A, B, and C in view of MECcheck and Jung, and further in view of Wares is not warranted and is hereby traversed. With regard to claim 32, to establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka and Martin*, 180 U.S.P.Q. 580 (C.C.P.A.

1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established *prima facie* obviousness. The portions of the Office Action in support of the rejection of claim 32 (pp. 46-47) fail to address each element of claims 1 and 2, from which claim 32 directly or indirectly depends, as called for by M.P.E.P. §706.02(j) in support of the rejection of this claim.

Assuming, *arguendo*, that the Examiner is relying on his anticipation arguments in support of his rejection of the parent claims, the limitations of claim 2 are nonetheless inadequately supported therein (*see Response*, pp. 30, 36 and 41-42, *supra*) while the cited references, alone or in combination, fail to teach or suggest at least the aforementioned “selecting” limitation of claim 1. In contradistinction, with regard the “selecting” limitation of claim 1, for example, the A B and C references teach that the BDA, instead of automatically selecting a set of items that satisfy a set of values, merely displays multiple design solutions for comparison *by the designer* in making his/her design choices, while the MECcheck reference teaches that “[t]he software enables *you* [i.e. the designer] to quickly compare different insulation levels in different parts of your building to arrive at a package that works best for you.” (*See Response*, pp. 45-47, *supra*).

Nor does Wares teach the foregoing limitations. As noted above, Jung cannot be relied on as teaching the foregoing limitations because Jung does not qualify as prior art. Applicants thus respectfully submit that the cited A, B, C and MECcheck references teach away from the claimed invention, with such a teaching to be considered against a finding to combine or modify

them. (*See Response*, p. 47, *supra*).

Thus, where the cited references, alone or in combination, fail to teach or suggest this limitation, claim 32, read respectively with all of the limitations of claims 1 and 2, does not define obvious subject matter, regardless of whether or not the added limitations of the dependent claim are taught therein. *See In re Royka and Martin*, 180 U.S.P.Q. at 583. Because claim 32 is patentably distinguishable from the prior art, the withdrawal of the rejection of the claim is respectfully requested. Furthermore, because claim 32 directly depends from improperly-rejected claim 2 (*see Response*, pp. 30, 36 and 41-42, *supra*), the withdrawal of the rejection of this claim is respectfully requested for this reason as well.

With further regard to claim 32, Applicants note that the Examiner has asserted that providing schedule and cost information as part of a proposal, wherein proposals/bids include/provide information that is relevant and used in evaluating projects, is “old and very well known.” Applicants respectfully submit that it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. M.P.E.P. §2144.03(A)(para. 2); *see In re Ahlert*, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970). Applicants respectfully submit that using cost and schedule information in the determining step of the claimed method requires knowledge peculiar to a particular art, and is not capable of such instant and unquestionable demonstration as to defy dispute. *See In re Ahlert*, 165 U.S.P.Q. at 420-21. The Examiner is thus respectfully invited to provide documentary evidence in support of his finding that the fact is well known in the art. M.P.E.P. §2144.04(C). If the Examiner is

relying on his personal knowledge of this fact, he is respectfully invited to provide an affidavit or declaration setting forth specific factual statements and explanations in support of the finding.

*Id.*; see 37 C.F.R. § 1.104(d)(2).

Claims 86, 87 and 88 directly depend from claim 32 and include all of the limitations of that claim plus additional limitations. Therefore, for at least the reasons set forth above in support of the non-obviousness of claim 32, Applicants respectfully submit that these claims are patentably distinguishable over the cited references as well. If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious. M.P.E.P. §2143.03(citing *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988)). The withdrawal of the rejection of these claims is thus respectfully requested. Furthermore, because claims 86, 87 and 88 indirectly depend from improperly-rejected claim 2 (see *Response*, pp. 30, 36 and 41-42, *supra*), the withdrawal of the rejection of these claims is respectfully requested for this reason as well.

With further regard to claims 86 and 88, Applicants note that the Examiner has asserted that determining delay costs based on the determined installation schedule (claim 86) and charging a fee (claim 88) are “old and very well known,” using these assertions as the *principal evidence* upon which the respective rejections are based. Applicants respectfully submit that “it is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection is based.” M.P.E.P. §2144.03(A)(para.3) and (E)(citing *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001)).

Applicants also respectfully submit that it is not appropriate for the Examiner to take

official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known.

M.P.E.P. §2144.03(A)(para. 2); *see In re Ahlert*, 165 U.S.P.Q. 418, 420 (C.C.P.A. 1970).

Applicants respectfully submit that determining delay costs based on the determined installation schedule (claim 86) and charging a fee (claim 88) requires knowledge peculiar to a particular art, and is not capable of such instant and unquestionable demonstration as to defy dispute. *See In re Ahlert*, 165 U.S.P.Q. at 420-21. The Examiner is thus respectfully invited to provide documentary evidence for each claim in support of his finding that the fact is well known in the art. M.P.E.P. §2144.04(C). If the Examiner is relying on his personal knowledge of this fact, he is respectfully invited to provide an affidavit or declaration setting forth specific factual statements and explanations in support of the finding. *Id.*; *see* 37 C.F.R. § 1.104(d)(2).

With regard to claim 80, the Examiner has provided no support for the rejection of claim 80 within section 15 of the Office Action, as required by M.P.E.P. §706.02(j). A withdrawal of the rejection of claim 80 is thus respectfully requested. It is noted, however, that claim 80 was also rejected as obvious in sections 11-12 of the Examiner's Office Action. If the Examiner's rejection of claim 80 under the present section of the Office Action (i.e. section 15) was in error and the Examiner nonetheless relies on the rejection of claim 80 as set forth in sections 11-12 of the Action, the Applicants respectfully direct the Examiner to pp. 44-48, of this Response, *supra*, which nonetheless traverses the rejection of claim 80 in response to those sections. Clarification of the rejection of claim 80 under section 15 of the Office Action is respectfully requested.

Claims 34 and 83

Claims 34 and 83 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck and Jung as applied to claim 33 and further in view of Wares. The rejection of claims 34 and 83 under §103 as unpatentable over references A, B, and C in view of MECcheck and Jung and further in view of Wares is not warranted and is hereby traversed. With regard to claim 34, Applicants note that the Examiner appears to base the obviousness rejection of the claim solely on the BDA in view of Jung. (*See Office Action*, pp. 47-48). Again, however, Jung does not qualify as prior art. (*See Response*, p. 55, *supra*). Thus, the withdrawal of the rejection of claim 34 is respectfully requested.

Claim 83 directly depends from claim 34 and includes all of the limitations of that claim plus additional limitations. Therefore, for at least the reasons set forth above, the withdrawal of the rejection of this claim is thus respectfully requested as well.

In summation, because of the foregoing reasons, a withdrawal of the rejection of claims 29, 32, 34, 80, 83 and 86-88 is respectfully requested.

16      35 U.S.C. §103(a) obviousness rejection (claims 39, 41)

Claims 39 and 41 stand rejected under 35 U.S.C. §103(a) as unpatentable over the BDA as evidenced by references A, B and C in view of MECcheck as applied to claims 33, 34 and 36 and further in view of Bosch. The rejection of claims 39 and 41 under §103 as unpatentable over references A, B and C in view of MECcheck and further in view of Bosch is not warranted and is hereby traversed. To establish *prima facie obviousness* of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (*citing In re Royka*

*and Martin*, 180 U.S.P.Q. 580 (C.C.P.A. 1974)). “All words in a claim must be considered in judging the patentability of that claim against the prior art. *Id.* (citing *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)).

Applicants respectfully submit that the Examiner has not established prima facie obviousness. The portions of the Office Action in support of the rejection of claims 39 and 41 (pp. 51-55) fail to address each element of claims 33, 34 and 36, from which claims 39 and 41 directly or indirectly depend. Again, with regard to claim 33, nowhere does the Office Action, as called for by M.P.E.P. 706.02(j) in support of the rejections of these claims, address where “code for selecting a set of items based on the calculated total first values” is taught or suggested by the BDA as evidenced by references A, B and C, alone or in combination..

Furthermore, Applicants respectfully submit that the rejection of claims 34 and 36, from which claims 39 and 41 directly or indirectly depend, is not properly supported anywhere in the Office Action. Claim 34 was rejected under section 15 of the Action in view of an improper prior art reference (Jung). (*See Response*, p. 61, *supra*). Claim 36 was improperly rejected in section 12 of the Action where the rejection of its parent (i.e., claim 34) was not properly supported therein. (*See Response*, p. 51, *supra*). In view of the foregoing and where the present section of the Action (i.e., section 16) fails to properly support the rejection of parent claims 34 and 36, as called for by M.P.E.P. §706.02(j), a withdrawal of the rejection of the claims 39 and 40 is warranted. Applicants thus respectfully request such a withdrawal.

In conclusion, it is respectfully submitted, that none of the documents, alone or in combination, teach the claimed invention. The present amendments to the claims and the

Application No. 09/788,470

Response and Amendment to Office Action of October 31, 2005

accompanying discussion are thus deemed to dispose of all issues in this case and to place this application in a condition for allowance. Early such action is solicited.

The prior art cited but not relied upon has been reviewed with interest. However, this prior art is not deemed to vitiate the patentability of the claimed invention.

Respectfully Submitted,

Dated: March 30, 2006

By: /Timothy G. Hofmeyer/  
Timothy G. Hofmeyer  
Registration No. 46,777  
Attorney for Applicants

Johns Manville  
Legal Department  
10100 West Ute Avenue  
P.O. Box 625005  
Littleton, Colorado 80162-5005  
(303) 978-2397 phone  
(303) 978-2323 fax

Customer No. 29602